

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DONALD E. HANEY

Appeal No. 2000-0819
Application 08/993,699

ON BRIEF

MAILED

APR 18 2001

**PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES**

Before CALVERT, STAAB, and McQUADE, Administrative Patent Judges.
CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 to 15, all the claims remaining in the application.

The claims on appeal are drawn to a method of sanding (claims 1, 3, 4 and 6 to 13), an article of wood (claims 2 and 5) and an orbital sander (claims 14 and 15), and are reproduced in the appendix of appellant's brief.¹

¹In reviewing the application, we note that the following claim language does not appear to have clear antecedent basis in

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The references applied in the final rejection are:

Haney (Haney '414)	5,443,414	Aug. 22, 1995
Haney (Haney '287)	5,702,287	Dec. 30, 1997

Applied herein in a rejection pursuant to 37 CFR 1.196(b) is the admitted prior art on page 1, line 16, to page 2, line 3, of appellant's specification (APA).

The claims on appeal stand finally rejected as follows:

- (1) Claims 14 and 15, unpatentable for failure to comply with 35 U.S.C. § 112, second paragraph.
- (2) Claims 1 to 13, unpatentable under 35 U.S.C. § 101 on the ground of double patenting, as claiming the same invention as claims 1 to 13 of Haney '287.
- (3) Claims 14 and 15, unpatentable under 35 U.S.C. § 101 on the ground of double patenting, as claiming the same invention as claims 2, 4, 5, 10 and 11 of Haney '414.

Rejection (1)

As stated in the final rejection (Paper No. 7), the grounds of this rejection are:

the specification, as required by 37 CFR 1.75(d)(1): "one thousand to five thousand inches-per-minute" (claim 3, line 12); "with an average magnitude . . . the first speed" (claim 4, line 2); "a series of loops . . . conveyor feed direction" (claim 12, lines 3 to 5). This deficiency should be corrected in any further prosecution.

(a) In claim 14, lines 11 and 12, the recitation that "the rotation of the shafts in the bearings causes the platen to move in a translational orbit" is

without supporting structure, in that no means to transmit the rotational motion of the shafts to a translational orbital motion of the platen is recited, and therefore is deemed incomplete.

(b) In claim 15, lines 3 and 4, "the second and third shafts" has no antecedent basis.

"The legal standard for definiteness [under § 112, second paragraph] is whether a claim reasonably apprises those of skill in the art of its scope." In re Warmerdam, 33 F.3d 1354, 1361, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994). We consider that this standard is met with regard to ground (a) of the rejection. While claim 14 does not expressly recite structure for performing the function of causing the platen to move in a translational orbit due to rotation of the shafts in the bearings, it does require a machine which functions in that manner. Thus, one of ordinary skill would, in our view, be reasonably apprised of what the scope of claim 14 is. As stated in In re Echerd, 471 F.2d 632, 635, 176 USPQ 321, 322 (CCPA 1973), "There is nothing intrinsically wrong in defining something by what it does rather than by what it is."

Concerning ground (b) of the rejection, appellant effectively acknowledges at pages 4 to 5 of the brief that "the second and third shafts" lacks proper antecedent support. This part of the rejection will, therefore, be summarily sustained.

Rejection (1) will not be sustained as to ground (a), but will be sustained as to ground (b).

Rejection (2)

The language of claims 1 to 13 is identical to that of claims 1 to 13, respectively, of the Haney '287 patent, except that instead of the recitation of "sandpaper" in line 4 of each of independent claims 1 and 3 on appeal, claims 1 and 3 of the patent recite "a sheet of sandpaper." The examiner rejected the claims under § 101, i.e., on the ground of "same invention" type double patenting, and takes the position that (answer, page 5):

the term "sandpaper" inherently implies a sheet, since as commonly understood, sandpaper is abrasive grit on a paper or other sheetlike substrate used in place of paper, such as cloth. Appellant has defended claims 1-13 as being patentable over his prior patent by insisting that other embodiments of "sandpaper" would not necessarily be formed as a sheet, giving roll and endless band as examples. First of all, in the examiner's view, a sheet is a sheet whether it is attached by it's [sic: its] ends to form a band or wrapped on a drum to form a roller. However, even if these hypothetical embodiments were not considered to come under the definition of sheets, Appellant's specification, claims and drawings gives absolutely no guidance in how anything but a single layer of sandpaper could be configured to work with the disclosed platen. In other words, it is not seen

how such hypothetical embodiments would be incorporated into the platen by a simple substitution for the abrasive sheet shown and disclosed therein.

The test for "same invention" type double patenting under § 101 is "whether a claim to one invention could be literally infringed without literally infringing the other." In re Hallman, 655 F.2d 212, 216, 210 USPQ 609, 612 (CCPA 1981). See also In re Deters, 515 F.2d 1152, 1157, 185 USPQ 644, 648 (CCPA 1975) ("Since it is possible to infringe claim 2 literally without infringing any of Deters patent claims literally, same-invention type double patenting is not present"). In the present case, therefore, the determinative question is whether a roll or endless band of sandpaper, which would literally infringe the application claims' term "sandpaper," would also literally infringe the term "a sheet of sandpaper" recited in the patent claims.

In general, words in a claim are to be given their ordinary and accustomed meaning, unless it appears that the inventor imparted a special meaning to a term, Multiform Dessicants Inc. v. Medzam Ltd., 133 F.3d 1473, 1477, 45 USPQ2d 1429, 1432 (Fed. Cir. 1998), and in considering the issue of double patenting, the patent disclosure may be consulted to determine the meaning of terms in the patent claims. In re Avery, 518 F.2d 1228, 1232, 186

USPQ 161, 164 (CCPA 1975); In re Dinwiddie, 347 F.2d 1016, 1018, 146 USPQ 497, 498 (CCPA 1965). Here, the Haney '287 patent shows in the drawings element 152, which appears to be a sheet of sandpaper but is described only as an "abrasive" (col. 5, lines 29 to 35); in any event, since Haney '287 does not give the term "a sheet of sandpaper" any special meaning, it will be given its ordinary and accustomed meaning, for the determination of which a dictionary is useful. Vanguard Prods. Corp v. Parker Hannifin Corp., 234 F.3d 1370, 1372, 57 USPQ2d 1087, 1089 (Fed. Cir. 2000).

The dictionary² defines "sheet" as "a usu. oblong or square piece of paper esp. in one of the various sizes in which paper is made according to the uses to which it is to be put." In light of this definition, we do not consider that in ordinary parlance one of ordinary skill would consider a roll or endless band of sandpaper to be "a sheet of sandpaper," as recited in the Haney '287 patent claims. For instance, if one were to order a sheet of sandpaper, one would expect the order to be filled by an oblong or square piece of sandpaper, rather than by a roll or endless band.

²Webster's Third New Int'l. Dictionary (1971).

The examiner's argument to the effect that the claim term "sandpaper" must be limited to a sheet because appellant does not disclose how any abrasive other than a sheet of sandpaper could be used with his disclosed apparatus is not considered relevant to the question of double patenting involved here. As stated in In re Vogel, 422 F.2d 438, 441, 164 USPQ 619, 622, "especially in non-chemical cases, . . . the words in a claim are generally not limited in their meaning by what is shown in the disclosure." The examiner's argument concerns not double patenting but rather the question of compliance with the first paragraph of § 112, an issue which is not before us. Cf. Johnson Worldwide Assocs. Inc. v. Zebco Corp., 175 F.3d 985, 993, 50 USPQ2d 1607, 1613 (Fed. Cir. 1999).

Accordingly, we will not sustain rejection (2).

Rejection (3)

In response to this rejection, appellant argues in his brief (pages 3 to 4) that claims 14 and 15 are not coextensive in scope with the corresponding claims of Haney '414 because, inter alia, the expression "an abrasive associated with the platen" in claim 14 (line 13) is less limited than the corresponding expression "a sheet of sandpaper secured over the platen's flat bottom surface"

recited in Haney '414 claims 2 and 5. This argument is clearly correct, and the examiner has not responded to it in the answer.

Rejection (3) therefore will not be sustained.

Rejections Pursuant to 37 CFR 1.196(b)

Pursuant to 37 CFR 1.196(b), we enter the following new rejections.

(I) Claims 1 to 13 are rejected on the ground of obviousness-type double patenting over claims 1 to 13, respectively, of Haney '287. As discussed above, the term "sandpaper" recited in claims 1 to 13 is generic to the term "a sheet of sandpaper" recited in independent patent claims 1 and 3. In such a situation, as stated in In re Goodman, 11 F.3d 1046, 1050, 29 USPQ2d 2010, 2016 (Fed. Cir. 1993), "the generic invention is 'anticipated' by the species of the patented invention. . . . Accordingly, absent a terminal disclaimer, [the application claims] were properly rejected under the doctrine of obviousness-type double patenting." See also Eli Lilly & Co. v. Barr Labs., Inc., 222 F.3d 973, 987, 55 USPQ2d 1609, 1619 (Fed. Cir. 2000) ("Our case law firmly establishes that a later genus claim is not patentable over an earlier species claim"), and cases cited therein.

(II) Claims 2 and 5 are rejected under 35 U.S.C. § 102(a) as being anticipated by the APA. Claim 2, which is representative of these two claims, reads:

2. An article of wood sanded according to the method of claim 1.

According to the APA, prior art sanding machines can leave sanding patterns in the product, and for wood products, "[t]o remove sanding patterns, finish sanding is often done by hand with a hand-held sander or with steel wool" (page 1, lines 24 and 25). At page 2, lines 1 to 3, appellant states that:

The invented sander provides an alternative to hand-held finishing sanders while removing sanding patterns. In other words, the invented sander eliminates the need for finish sanding to be done by hand.

Also, on page 7, line 13, it is disclosed that the dual rotation in appellant's machine "simulates the motion of sanding by hand," and at page 10, line 11, that all cross-grain sanding patterns are substantially eliminated.

It is well settled that the product of a process is unpatentable if it is the same as or obvious from a prior art product, even if the prior product was made by a different process. In re Thorpe, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985). Since the above-quoted disclosed purpose of appellant's sander is to remove the sanding patterns which the

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prior art removed by finish sanding by hand, and appellant's machine is disclosed as simulating sanding by hand, an article of wood sanded by appellant's claimed method would, prima facie, be the same as a prior art article of wood which had been finish sanded by hand. The burden shifts to appellant "to prove that the prior art products do not necessarily or inherently possess the characteristics of his claimed product." In re Thorpe, supra; In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

Remand to the Examiner

The application is remanded to the examiner to determine whether claims 14 and 15 should be rejected over any of the claims of Haney '414 on the ground of obviousness-type double patenting. The examiner should note that in making this determination, each of claims 14 and 15 should be compared to a single claim of the patent. See MPEP § 804, p. 800-18, col. 1, items (A).

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Conclusion

The examiner's decision (i) to reject claims 14 and 15 under § 112, second paragraph, is reversed as to claim 14 and affirmed as to claim 15, and (ii) to reject claims 1 to 15 under 35 U.S.C. § 101 is reversed. Claims 1 to 13 are rejected pursuant to 37 CFR 1.196(b), and the application is remanded to the examiner.

In addition to affirming the examiner's rejection of one or more claims, this decision contains new grounds of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63,122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides, "A new ground of rejection shall not be considered final for purposes of judicial review."

Regarding any affirmed rejection, 37 CFR § 1.197(b) provides:

(b) Appellant may file a single request for rehearing within two months from the date of the original decision

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new grounds of

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rejection to avoid termination of proceedings (37 CFR § 1.197(c))
as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

Should the appellant elect to prosecute further before the Primary Examiner pursuant to 37 CFR § 1.196(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the appellant elects prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for reconsideration thereof.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).


AFFIRMED-IN-PART 196(b); REMAND

Jan A Calvert
JAN A. CALVERT

IAN A. CALVERT
Administrative Patent Judge

Lawrence. State

LAWRENCE J. STAAB
Administrative Patent Judge


JOHN P. McQUADE
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